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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/909,470	07/19/2001	Franz A. Dosch	041165-9017-00	7242
23409	7590	02/23/2005	EXAMINER	
MICHAEL BEST & FRIEDRICH, LLP 100 E WISCONSIN AVENUE MILWAUKEE, WI 53202			JACKSON, JENISE E	
			ART UNIT	PAPER NUMBER
			2131	

DATE MAILED: 02/23/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

09/909,470

Applicant(s)

DOSCH, FRANZ A.

Examiner

Jenise E Jackson

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-19 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-19 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- ☒ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_.
- ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_.
- ☐ Notice of Informal Patent Application (PTO-152)
- ☐ Other: \_\_\_\_.

**DETAILED ACTION**

***Claim Rejections - 35 USC § 102***

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

2. Claims 1-3, 8-11, 14, 17-18 are rejected under 35 U.S.C. 102(e) as being anticipated by Ausems(6,434,403).

3. As per claim 1, Ausems et al. discloses an internet terminal(see col. 5, lines 47-59, 65-67. col. 6, line 1), including a touch-sensitive display(see col. 4, lines 21-23, 32-39, col. 6, lines 10-12), and a means for communication with a connectable identification module(see col. 4, lines 40-50), wherein the terminal receives configuration data from the identification module for a connection to the internet(see col. 4, lines 40-50, col. 5, lines 66-67, col. 6, lines 1, and 27-44).

4. As per claim 2, Ausems et al. discloses wherein the terminal is designed as a WebPad, Ausems discloses a Webpad, because Ausems discloses that the PDA can be coupled to a modem to allow access to the Internet(see col. 5, lines 48-50, 66-67, col. 6, lines 1, col. 7, lines 17-21).

5. As per claim 3, Ausems et al. discloses a means for the wireless communication (see col. 3, lines 5-14), preferably according to the DECT standard, inherent, because Ausems et al. discloses a pda telephone that operates wirelessly, with a base station, wherein the terminal sets

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up the connection via the means for wireless communication (see col. 5, lines 49-67, col. 6, lines 23-32).

6. As per claim 8, Ausems discloses wherein the identification module is designed as a chip card(see col. 4, lines 47-50).

7. As per claim 9, Ausems discloses wherein the identification module is designed as a transponder (see col. 6, lines 20-32).

8. As per claim 10, Ausems discloses an internet terminal that access the internet(see col. 5, lines 47-67, col. 6, lines 1). Ausems discloses configuration data for a connection to the Internet (see col. 4, lines 40-50, col. 5, lines 66-67, col. 6, lines 1 and 27-44).

9. As per claim 11, Ausems discloses wherein the configuration data includes access to an internet service provider, is inherent in Ausems, because Ausems discloses access to the Internet using a smart card(see col. 4, lines 40-50, col. 5, lines 66-67, col. 6, lines 1 & 27-44).

10. As per claim 14, Ausems discloses configuration data includes a service data which specify enabled services(see col. 6, lines 38-44).

11. As per claim 17, Ausems discloses wherein the identification module is designed as a chip card (see col. 4, lines 47-50).

12. As per claim 18, Ausems discloses wherein the identification module is designed as a transponder(see col. 6, lines 20-32).

*Claim Rejections - 35 USC § 103*

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

13. Claims 4-7, 12-13, and 19 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ausems(6,434,403) in view of White et al.(6,199,114).

14. As per claim 4, Ausems discloses a terminal that communicates with a identification module(i.e. smartcard)(see col. 6, lines 45-57). However, Ausems is silent on wherein the terminal sets up the connection automatically after communication with the identification module. White et al. discloses wherein the terminal sets up the connection automatically after communication with the identification module(see col. 1, lines 61-67, col. 2, lines 1-3).

15. It would have been obvious to one of ordinary skill in the art at the time of the invention to include setting up the connection automatically after communication with the identification module of White with Ausems, the motivation is that a number of people are using the Internet and the Web in recent years(see col. 1, lines 23-25 of White et al.). Some Internet users gain access to the services of the Internet and the Web thorough user accounts provided by the employer, others access the Internet from home(see col. 1, lines 27-30 of White et al.). The users accounts are subjected to intrusion by merely providing a username and password, that are usually chosen by a user(see col. 1, lines 30-34). White system protects a user's account, by a user supplying identification module(i.e. smartcard) in order to access the Internet. Therefore, the authorized user is allowed access to the Internet.

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16. As per claim 5, same motivation applies above. White et al. discloses wherein the terminal sets up the connection via an Internet service provider determined by the configuration data(see col. 2, lines 10-21).

17. As per claim 6, Ausems does not disclose wherein the terminal activates itself automatically for communication with the identification module when the identification module is coupled to the terminal. However, White et al. discloses wherein the terminal activates itself automatically for communication with the identification module when the identification module is coupled to the terminal(see col. 1, lines 61-67, col. 2, lines 1-3). It would have been obvious to one of ordinary skill in the art at the time of the invention to include wherein the terminal activates itself automatically for communication with the identification module when the identification module is coupled to the terminal of White et al. with Ausems, the motivation is the system determines whether the smart card has been entered, thus communication with the terminal can take place(see col. 1, lines 61-67, col. 2, lines 1-3 of White).

18. As per claim 7, same motivation applies above. White et al. discloses wherein the terminal sets up the connection only after communication with an identification module, which contains key data enabling the terminal(see col. 1, lines 61-67, col. 2, lines 1-3, col. 8, lines 11-15).

19. As per claim 12, Ausems does not disclose wherein the configuration data includes the subscriber data identifying a user of the terminal. White discloses wherein the configuration data includes the subscriber data identifying a user of the terminal(see col. 7, lines 16-30). The motivation to include the configuration data that includes the subscriber data identifying a user of

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the terminal with Ausems is that a user's account cannot access the terminal unless the smart card is supplied from the user(see col. 7, lines 8-15 of White).

20. As per claim 13, Ausems does not disclose wherein the configuration data includes key data, which enable the terminal. White et al. discloses wherein the configuration data includes key data, which enable the terminal(see col. 7, lines 16-30). The motivation is that when the user is authenticated the terminal can be accessed(see col. 7, lines 16-30 of White).

23. As per claim 19, Ausems discloses an identification module including configuration data(see col. 4, lines 40-50, col. 5, lines 66-67, col. 6, lines 1 and 27-44); and an internet terminal including a touch-sensitive display (see col. 4, lines 21-23, 32-39, col. 6, lines 10-12), and a means for communication with the connectable identification module(see col. 4, lines 40-50), wherein the internet terminal receives the configuration data from the identification module for a connection to the internet(see col. 4, lines 40-50, col. 5, lines 66-67, col. 6, lines 1 and 27-44). Ausems does not disclose wherein the specific service provider access to the internet, the subscriber obtains data representative of the information via the access and evaluates the data by means of the internet terminal, and the internet terminal obtains access to the internet only in combination with the identification module of the specific service provider. White does disclose wherein the specific service provider access to the internet, the subscriber obtains data representative of the information via the access and evaluates the data by means of the internet terminal, and the internet terminal obtains access to the internet only in combination with the identification module of the specific service provider(see col. 7, lines 8-30). It would have been obvious to one of ordinary skill in the art at the time of the invention to include White with Ausems, because the system determines whether the smart card has been entered, thus

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communication with the terminal can take place(see col. 1, lines 61-67, col. 2, lines 1-3 of White).

24. Claims 15-16 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ausems in view of White et al. as applied to claim 10 above, and further in view of Van Horne(6,233,604).

25. As per claim 15, Ausems-White combination do not disclose wherein the configuration data includes payment data permitting remuneration for the connection. Van Horne discloses wherein the configuration data includes payment data permitting remuneration for the connection (see col. 4, lines 22-35 of Van Horne). It would have been obvious to one of ordinary skill in the art at the time of the invention to include configuration data includes payment data permitting a remuneration for the connection of Van Horne with Ausems-White, the motivation is that clients can be automatically configured for accessing the network and billing(see col. 4, lines 40-42 of Van Horne).

26. As per claim 16, same motivation applies above. Ausems-White combination do not discloses wherein the configuration data includes credit data, which permit an actual accounting of the connection. Van Horne discloses wherein the configuration data includes credit data which permit an actual accounting of the connection (see col. 4, lines 22-35, col. 13, lines 10-30).

### *Conclusion*

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jenise E Jackson whose telephone number is (571) 272-3791. The examiner can normally be reached on M-Th (6:00 a.m. - 3:30 p.m.) alternate Friday's.



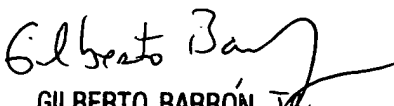
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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Ayaz Sheikh can be reached on (571) 272-3795. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



February 17, 2005



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